

MEMORANDUM

DATE: December 10, 2003

TO: Patent Examining Corps

FROM: Stephen G. Kunin
Deputy Commissioner
for Patent Examination Policy

SUBJECT: **Transitional practice for supplying a copy of a provisional application relied upon to give prior art effect under 35 U.S.C. § 102(e) to a reference applied in a rejection**

Summary: When the 35 U.S.C. § 102(e) prior art date of a reference¹ used in a rejection² is the filing date of a provisional application, in addition to listing the reference in the usual manner on the PTO-892 form, the examiner must:

- 1) List the provisional application number in the bottom section of the PTO-892 form under the heading "NON-PATENT DOCUMENTS" (See Appendix 2), and
- 2) Include (new) form paragraph 7.82.02 (See Appendix 1) (now available in OACS) in the written Office action.

The listing of the provisional application number in the bottom section of the PTO-892 form will cause a copy of the provisional application to be mailed to applicant with the Office action. This is a transitional practice which shall be used until Internet access to provisional applications (when they are referred to in application publications or patents) becomes available to the public (expected to be in July of 2004).

Effective period for transitional practice: From the date of this memorandum until further notice.

Background: A reference may be used as prior art as of the filing date of a provisional application of which benefit is claimed under 35 U.S.C. § 119(e) or § 365(c) only *to the extent the provisional application provides 35 U.S.C. § 112, 1st paragraph support* for the part of reference relied upon in making the rejection. See, e.g., *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294, 63 USPQ2d 1843, 1846 (Fed. Cir. 2002). Conversely, if the provisional application does not provide support for the part of the reference relied upon to make a rejection, then the filing date of the provisional application cannot be relied upon as the § 102(e) date of the reference.

Appendix 3 provides examples of when and when not to list on the PTO-892 form a provisional application of which benefit is claimed by a reference applied in a rejection.

How copy of provisional application gets made/mailed with the Office action.

If the examiner has a copy of the provisional application(s), the copy should be submitted with the Office action in the usual manner that copies of references are submitted with actions to

be mailed. Although not required, the examiner can, in most instances where the provisional application was scanned, print a copy of the provisional application at his/her own workstation using the eDAN software program. See **Appendix 4**.

A listing of provisional application number(s) on the bottom of the PTO-892 form will be a trigger to the USPTO mailing contractor to include a copy of the provisional application(s) with the mailed Office action, by using any examiner supplied copy, or any copy that the contractor makes from the Office's PACR or IFW databases.

In the event that the mailing contractor cannot obtain a copy of the provisional application from PACR or IFW, a copy of the provisional application will not be mailed with the Office action, and the USPTO mailing contractor will *make the notation*: "**Copy not readily available**" next to the provisional application number on the bottom of the PTO-892 form.

If the examiner subsequently receives a request from applicant for a copy of a provisional application relied upon for prior art effect of an applied reference because the initial Office action mailed during the effective period of this memorandum did not provide one, the procedure set forth in **Appendix 5** must be followed.

Questions or assistance: Questions about this transitional practice should be directed to James Engel, Legal Advisor, Office of Patent Legal Administration at 308-5106.

Appendices: 1. Form Paragraph 7.82.02 (new)

- 2. Sample of PTO-892 form with a provisional application number listed**
- 3. Examples of when to list a provisional application on the PTO-892 form**
- 4. Obtaining copies of provisional applications from a database**
- 5. What to do when applicant requests a copy of a provisional application?**

¹ The reference must:

- 1) Be a U.S. patent, a U.S. patent application publication or any WIPO publication usable under 35 U.S.C. § 102(e);
- 2) Claim the benefit under 35 U.S.C. §§ 119(e) or 365(c) of a prior provisional application;
- 3) Have to use the filing date of the provisional application for its 35 U.S.C. § 102(e) date; and
- 4) Be applied in a rejection.

Note: If the reference has a good actual filing date, or a good effective (benefit) filing date under 35 U.S.C. § 120 or § 365(c) from a prior nonprovisional application or international application usable under 35 U.S.C. § 102(e) (i.e., prior to the earliest effective filing date of the application being examined), then the reference does NOT have to rely on the filing date of any provisional application.

² If a reference is only cited of interest, a copy of any referred to prior provisional application should NOT be listed by the examiner on the bottom of the PTO-892 because a copy should not be supplied to applicant.